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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,438	01/15/2004	Chi-Feng Lan	040-501	5615
35870	7590	07/02/2007	EXAMINER	
APEX JURIS, PLLC TRACY M HEIMS LAKE CITY CENTER, SUITE 410 12360 LAKE CITY WAY NORTHEAST SEATTLE, WA 98125			CREPEAU, JONATHAN	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/758,438	Applicant(s) LAN, CHI-FENG	
	Examiner Jonathan S. Crepeau	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office action addresses claims 1-3 and 5. Claims 2 and 3 remain rejected under 35 USC 102, and claims 1 and 5 remain rejected under 35 USC 103. However, a new ground of rejection under 35 USC 102 has been applied to claim 1, which was not necessitated by amendment. Accordingly, this action is non-final.

Claim Rejections - 35 USC § 102

2. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al (U.S. Patent 7,041,400).

Regarding claim 2, the reference is directed to a battery pack comprising a battery module (100), a first contact (300), a second contact (500), a controller (210), and a memory module (230) (see Fig. 2). The second contact is connected to a USB transmission interface (see col. 4, line 25). The first contact is connectable to a portable electronic apparatus and transmits data and power thereto (see col. 3, line 54 et seq), and the second contact is connectable to an electronic apparatus and transmits data thereto (see col. 4, line 34 et seq.). Regarding claim 3, the reference further discloses a protection circuit (220), which has the function of regulating battery voltage to the various battery pack components (see col. 1, line 29).

Regarding claim 1, the reference teaches battery module (100), a first contact (500), a second contact (300), a controller (210), and a memory module (230) (see Fig. 2). The second

contact is connected to an SMBUS or a one or two-wire (a)synchronous transmission interface (see col. 3, line 8). The second contact is connectable to an electronic apparatus and transmits data and power thereto (see col. 3, line 54 et seq), and the first contact is connectable to a portable electronic apparatus and transmits data thereto (see col. 4, line 34 et seq.). The battery is capable of being recharged when the second connector (300) is connected to the electrical apparatus (see col. 3, line 21).

Thus, the instant claims are anticipated.

Claim Rejections - 35 USC § 103

3. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al.

Kim et al. teach a battery pack comprising a battery module (100), a first contact (300), a second contact (500), a controller (210), and a memory module (230) (see Fig. 2). The second contact is connected to a USB transmission interface (see col. 4, line 25). The first contact is connectable to a portable electronic apparatus and transmits data and power thereto (see col. 3, line 54 et seq), and the second contact is connectable to an electronic apparatus and transmits data thereto (see col. 4, line 34 et seq.). Regarding claim 3, the reference further discloses a protection circuit (220), which has the function of regulating battery voltage to the various battery pack components (see col. 1, line 29). The reference further teaches that the battery module can be charged and discharged through the first connector 300.

However, the reference does not expressly teach that the battery module is chargeable through the second connector (500), as recited in claim 1.

However, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the artisan would be motivated to modify the system of Kim et al. so as to allow for battery recharging through the second contact. As disclosed in the reference, this contact is designed as a USB port or other wired interface. Since this interface is designed for connection to an apparatus such as a computer, it would be advantageous to be able to recharge the batteries in the battery module when the battery pack is attached to the computer or other apparatus in order to make efficient use of time while the battery pack is exchanging data with the computer. As such, the claimed subject matter would be rendered obvious to the skilled artisan.

Response to Arguments

4. Applicant's arguments filed April 24, 2007 have been fully considered but they are not persuasive. With respect to independent claims 1 and 2, Applicants state that the input/output port (500) of Kim et al. is different from the second connector of the present invention. In particular, the following statement is made with regard to the present invention:

When the first connector (21) is electrically connected to the portable electrical apparatus, the portable electrical apparatus is allowed to retrieve the data in the memory (23) through the controller (22). However, when the second connector is electrically connected to the electrical apparatus, the electrical apparatus is allowed to retrieve the data in the memory, **regardless of the connection between the portable electrical apparatus and the first connector (21)**, through the transmission interface and the controller. Kim et al. is silent on this point and does not teach or suggest this limitation. (emphasis added)

However, it is noted that the features upon which applicant relies (i.e., the emphasized portion above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, even if all of the limitations in the above passage are considered, it is the Examiner's position that Kim et al. is capable of performing the claimed functions. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the recitations of the electrical apparatuses being "allowed to retrieve" the data in memory is an intended use of the device of Kim et al. and is not sufficient to patentably distinguish therefrom as long as the device of Kim is capable of being operated this way.

Regarding amended claim 1 (incorporating the subject matter of cancelled claim 4), the claim has also now been rejected under 35 USC 102 since the connectors of the reference can be interpreted differently regarding the claimed "first" and "second" designations. However, the previous ground of rejection of claims 1 and 5 under 35 USC 103 has also been maintained. Regarding the Examiner's position that it would be obvious to provide a charging capability with the second connector (500) of Kim et al. since this connector may be connected to a computer, Applicants generally assert that a *prima facie* case of obviousness has not been made but do not make specific arguments as to the deficiencies of the Examiner's rationale. It is submitted that, as explained in the rejection, it would be beneficial to include a battery charging capability in

both of Kim's connectors as this would allow greater flexibility in battery charging and would permit charging from a non-portable power source, i.e., a power source such as a desktop computer connected to the AC power grid. Applicant has not made a persuasive case as to why the subject matter of claims 1 and 5 is non-obvious, i.e., why one of skill in the art would not be motivated to make the proposed changes, or that the proposed changes may not be possible or feasible in the device of Kim et al. Accordingly, the rejection under 35 USC 103 is maintained.

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Crepeau whose telephone number is (571) 272-1299. The examiner can normally be reached Monday-Friday from 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan, can be reached at (571) 272-1292. The phone number for the organization where this application or proceeding is assigned is (571) 272-1700. Documents may be faxed to the central fax server at (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jonathan Crepeau
Primary Examiner
Art Unit 1745
June 28, 2007